

**Remarks:**

Claims 1-4, 7-13, and 16-23 are pending. Claims 1-4, 7-13, and 16-23 are rejected under 35 U.S.C. §103. This application is amended by the virtue of this response, pursuant to 37 CFR 1.121. Please amend claims 19 and cancel claims 1-18. No new matter is added. Support for the amended claim is provided within the specification and the claims as filed, and particularly in paragraph [0031].

The Applicant is not conceding that the subject matter recited in the amended or canceled claims is not patentable over the art cited by the Examiner. The amended, withdrawn or cancelled claims are provided solely to facilitate expeditious prosecution of the allowable subject matter. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or cancelled claims in one or more continuing applications.

**Claim of Priority:**

Applicant notes that the Examiner has not acknowledge the Applicant's claim of foreign priority under 35 U.S.C. § 119(a). None of the boxes were marked on the Office Summary page. Please let us know if all, some or none of the copies have been received.

**Figures:**

Applicant notes that none of the boxes were marked on the Office Summary page to indicate that the Examiner has accepted the Drawings. Please advise.

**§103 Rejection(s):**

Claims 1-4, 7-13, and 16-23 remain rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,359,881 to Gerszberg et al. (hereafter "Gerszberg '881") in view U.S. Patent No. 5,936,941 to Kondo et al. (hereafter "Kondo") and further in view of U.S. Patent Publication No. 2001/0040621 to Gerszberg et al. (hereafter "Gerszberg '621"). This rejection is respectfully traversed.

It has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,<sup>1</sup> to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;
- (c) Use of known technique to improve similar devices (methods, or products) in the same way;
- (d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; etc.

The claimed subject matter is directed to a method for displaying information on a plurality of terminals connected to a network, the method comprising: determining a call status of each of a plurality of terminals in a network based on call status information included in call setup information received from each of the plurality of terminals, wherein the call status is one of an on-hook status and an off-hook status; and broadcasting display content information to all

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<sup>1</sup> *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-1741, 82 USPQ 2d 1385, 1395-97 (2007).

of the plurality of terminals in the network, in response to determining that more than a first number of the terminals in the network are in the on-hook status.

The on-hook status indicates that the terminal has not established a communication connection with another terminal for the purpose of communicating voice data; unicasting display content information to a subset of plurality of terminals in the network, in response to determining that less than a second number of terminals in the network are in the on-hook status; wherein each of the plurality of terminals that is in the on-hook status displays the transmitted information while the terminal is in the on-hook status, wherein each of the plurality of terminals that is in the off-hook status does not display the transmitted information while the terminal is in the off-hook status, and wherein the transmitted information comprises at least one of an advertisement, a guide, and a bulletin.

The cited references by the Examiner fail to teach or suggest all the above structural and functional elements in the manner combined. It is noteworthy that in the claims “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.” MPEP § 2173.05. As provided in further detail below, the cited references fail to teach and suggest all the above-noted elements and functional relationship recited in the pending claims.

Gerszberg ‘881 is directed to architecture capable of utilizing the existing twisted pair interface between customer premises equipment and an associated serving local switching office. See Abstract. The architecture allows a videophone to display advertising when the videophone is not in active use. See column 11, lines 65-66. Gerszberg ‘881 fails to teach or suggest all of the claimed elements. Particularly, Gerzberg ‘881 fails to teach selectively broadcasting or unicasting to the terminals in the network based on the number of terminals that are in the on-hook status. The Examiner is requested to point out portions of the reference that teach the same with specificity or otherwise withdraw the 103 grounds of rejection.

Kondo is directed to a communication system including a management terminal and a plurality of communication terminals connected to a communication network. The management terminal requests transmission of certain status information in a call setup message. Kondo fails to cure the deficiencies of Gerszberg '881 as Kondo also fails to teach or suggest all the claimed elements. The status information disclosed in Kondo is patentably distinguishable from the call status recited in the claims. That is, the status information in Kondo refers to information that is required by the management terminal to manage the communication terminals such as information related to failures or abnormal operations. See column 1, lines 44-46; column 2, lines 23-25. In contrast, the claimed call status information in the pending claims refers to an on-hook or off-hook status which is related to whether a terminal is being used to make a call. For this reason alone, one of ordinary skill would not have been motivated to combine the above cited references together in the direction of the claimed subject matter.

Finally, Gerszberg '621 is directed to an advertisement system for displaying advertisements on a video-enabled telephone when the telephone is linked with a non-video enabled telephone and/or when the videophone is put on hold. Gerszberg '621 also fails to cure the deficiencies of Gerszberg '881 and Kondo. Particularly, Gerszberg '621 cannot be relied on by the Examiner as a complimentary reference to the above two primary and secondary references, where the primary reference fails to teach an explicitly recited feature (i.e., broadcasting / unicasting based on the number of terminals in the on-hook status) and the secondary reference is patentably distinguishable from the claimed subject matter.

The question of whether a cited reference can properly be modified in a §103 rejection is not whether a particular limitation was known at time of invention, but rather whether there is a reason that would make it obvious for one of ordinary skill in the art at the time of the invention to modify the cited reference to include that particular limitation. As the U.S. Supreme Court has affirmed, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1397 (2007).

Additionally, it is improper to use Applicant's disclosure as a road map for selecting and combining prior art references. See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Applicant respectfully submits that in the absence of any legitimate reason that it would be obvious to combine the cited references; the Office Action has used Applicants' claims as a road map for modifying the cited reference. Respectfully, §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed. Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by

hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,<sup>2</sup> or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.<sup>3</sup>

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn. For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in the claims. Therefore, it is respectfully submitted that the claims are in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, by way of telephone (213) 623 2221 or email [jfar-hadian@lhlaw.com](mailto:jfar-hadian@lhlaw.com), to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: September 24, 2009

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<sup>2</sup> *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984).

<sup>3</sup> “The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner.”